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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/628,752      | 07/28/2003  | Kyoko Hamahara       | 1244-03             | 4858             |

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IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP  
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EXAMINER

ZIMMERMAN, JOHN J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1775

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,752

Applicant(s)

HAMAHARA ET AL.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## FIRST OFFICE ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura (Japanese publication 2002-004019).
4. Nomura discloses that steel sheet for automobile manufacture having a surface roughness Ra of 0.8  $\mu\text{m}$  or more according to JIS B 0610 (e.g. see paragraphs [0012], [0024]) and a PPI value of 150-300 (e.g. see paragraphs [0016]-[0017]). Specific roughness and PPI values are shown in Figure 2. Nomura also discloses that the steel sheet is a galvanized steel sheet (e.g. hot-dipped zinc - paragraph [0023]) and further provided with a chemical conversion coating

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(e.g. paragraph [0030]). An electrodeposition painting (e.g. middle coat) and a painted coat (finishing) is further applied (e.g. see paragraph [0030]). Although Nomura may describe the surface roughness Ra as center line average roughness than arithmetic mean roughness, it would be understood by one of ordinary skill in the art that various standard methods of measuring the roughness of the steel sheet can be used to optimized the surface of the steel sheet of Nomura with similar results. Selection one measurement standard over another would be a mere matter of choice. Regarding the ranges for the surface roughness Ra and the PPI values of Nomura, these ranges clearly overlap the ranges of the pending claims. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected the overlapping portion of the range disclosed by the reference because overlapping ranges have been held to be a prima facie case of obviousness, see *In re Malagari*, 182 USPQ 549. Regarding claim 2 (and 8), given the similarity of Nomura's painted steel sheets to those of the pending claims, the spectral analysis obtained by Fourier transformation of a surface roughness measurement curve would be expected to be the same even though not described by Nomura. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

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5. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura (Japanese publication 2002-004019) as applied to claims 1-6 above, and further in view of Hamahara (JP 2001-152355).

6. Nomura discloses a sheet for automobile manufacture as described above. Nomura may differ from the claims in that while Nomura uses a chemical conversion coating before electrodeposition painting, Nomura may not disclose that a zinc phosphate layer is formed. Hamahara, however, clearly discloses that using a zinc phosphate film on galvanized steel sheet for automobile manufacture results in excellent press-formability, chemical conversion treatability and electrodeposition painting of steel sheets (e.g. see paragraphs [0001], [0022], [0099]). In view of Hamahara, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a zinc phosphate layer for the galvanized steel sheet of Nomura because Hamahara discloses that this treatment will improve press-formability and improve chemical conversion coating treatability.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited references of record serve to further establish the level of ordinary skill in the art at the time the invention was made. Of particular relevance are Iwai (U.S. Patent 5,853,850), Sodani (U.S. Patent Application Publication 2003/0012978), Nakayama (JP 06-246306), Nakayama (JP 06-269803) and Honda (JP 2003-013192) because these

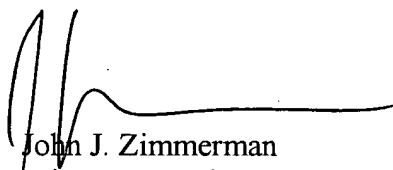
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references show the conventional optimization of surface roughness and/or PPI in steel sheets.

These references, however, fail to describe the use of electrodeposition painting with the substrates and, as detailed in applicant's disclosure, the issues related to the nature of electrodeposition painting result in distinct deposition considerations and also distinct resultant paint coatings. Therefore distinction has been given to the recitation in the pending claims that the coated steel sheet is provided with an "electrodeposition" painting.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Zimmerman  
Primary Examiner  
Art Unit 1775

jjz  
June 20, 2005